

REMARKS

The Official Action mailed January 28, 2010, the Interview Summary mailed March 23, 2010, and the Advisory Action mailed March 23, 2010, have been received and their contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to May 28, 2010. Also, filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 16, 2007, and June 14, 2007. However, the Applicant has not received acknowledgment of the Information Disclosure Statement filed on March 1, 2010. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced Information Disclosure Statement.

Claims 1, 3, 11, 18, 26, 28, 32, 34, 37, 39, 42, 44, 45, 47, 50, 52, 53, 55, 58, 60, 69, 71, 74, 76, 77, 79 and 82 are pending in the present application, of which claims 1, 3, 26 and 28 are independent. Claims 1, 3, 26 and 28 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Advisory Action maintains the rejection at paragraphs 3 to 10 of the Official Action, which reject claims 1, 3, 11, 18, 26, 28, 32, 34, 37, 39, 42, 44, 45, 47, 50, 52, 53, 55, 58, 60, 69, 71, 74, 76, 77, 79 and 82 as obvious based on various combinations of U.S. Publication No. 2003/0016349 to Tsumura; U.S. Patent No. 6,647,148 to Ozawa; U.S. Publication No. 2005/0041226 to Tanaka; U.S. Publication No. 2004/0228526 to Lin; U.S. Publication No. 2003/0142298 to Ujihara; and U.S. Patent No. 6,861,614 to Tanabe. The Applicant respectfully submits that a *prima facie* case of obviousness

cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1 and 3 have been amended to recite producing a digital image by taking a visible light dark field photograph of a semiconductor film, the semiconductor film having a crystallinity that has been improved by irradiating an energy beam; and independent claims 26 and 28 have been amended to recite producing a digital image by taking a visible light dark field photograph of the substrate. These features are supported in the present specification, for example, by the Abstract, and paragraphs [0021], [0025] or [0098] of the pre-grant publication of the present application, i.e. U.S. Publication No. 2004/0254769. Also, paragraph [0156] discloses that "[a] pattern diagram using a ring light 1611 is shown as an example of photographing a dark field image." Further, Figures 7-9 show examples

of dark field images used in the method for testing disclosed in the present specification. For the reasons provided below, Tsumura, Ozawa, Tanaka, Lin, Ujihara and Tanabe, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Applicant respectfully submits that one fundamental difference between the present invention and the cited prior art is the use of dark field photography. The Official Action appears to concede this point in stating, as a response to the Applicant's comments, that "the claims do not contain any limitation specifying and/or requiring such dark field photography" (page 2, third full paragraph, last line; Paper No. 20100524). The Applicant respectfully submits that none of the cited prior art references teaches or suggests the feature of "dark field photography." Also, the Applicant respectfully submits that one of ordinary skill in the art at the time of the present invention would not have had sufficient reasons to modify the scanning method using a laser beam having a specific wavelength disclosed by Tsumura to achieve the features of the present invention including dark field photography.

Therefore, the Applicant respectfully submits that Tsumura, Ozawa, Tanaka, Lin, Ujihara and Tanabe, either alone or in combination, do not teach or suggest producing a digital image by taking a visible light dark field photograph of a semiconductor film, the semiconductor film having a crystallinity that has been improved by irradiating an energy beam; or producing a digital image by taking a visible light dark field photograph of the substrate.

Since Tsumura, Ozawa, Tanaka, Lin, Ujihara and Tanabe do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
3975 Fair Ridge Drive
Suite 20 North
Fairfax, Virginia 22033
(571) 434-6789